

Appl. No. : 10/770,739
Filed : February 3, 2004

REMARKS

With this amendment, Claims 1-3 and 8-28 are pending in the present application. Applicant has currently amended Claim 20, canceled Claims 4-7, and added Claims 27-28. In view of these amendments and the following remarks, Applicant respectfully submits that all of the claims of the above-identified application are in condition for allowance.

Claim Rejection – 35 U.S.C. § 102

The Examiner has rejected Claims 1-3, 8-19, and 22-26 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,425,986 to Guyette. However, to maintain such a rejection, the “identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). Specifically, Guyette cannot anticipate those claims unless Guyette either expressly or inherently discloses each and every limitation recited in Claims 1-3, 8-19, and 22-26. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987) (“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”). Guyette does neither.

Guyette Does Not Expressly Disclose the Claimed Invention

Guyette does not expressly disclose, *inter alia*, a building material having a stress-relieving elastomer or elastomeric film. Indeed, the Examiner has not pointed to any section of Guyette that references an elastomer or even discusses a layer having elastomeric properties. If there was such a section in Guyette, the Examiner would surely have pointed it out to Applicant. Instead the Examiner points to and relies upon the adhesive 20 of Guyette for support. In particular, the Examiner states that “[a]dhesives *can* be elastomers.” (Office Action at p. 4) (emphasis added). Yet, there is no indication by Guyette that its adhesives are indeed elastomers. Moreover, Claims 22-26 recited specific limitations that are nowhere to be found in Guyette. And while these facts need no further comment, Weiling Peng, a person of ordinary skill in the art, has reviewed Guyette and has also reached the conclusion that Guyette does not mention or suggest adhesive 20 as having elastomeric properties, let alone the specific properties recited in Claims 22-26. (*see* Peng Declaration at ¶¶ 12-16.). Therefore, it is clear that Guyette does not expressly disclose each and every limitation claimed in Claims 1-3, 8-19, and 22-26.

Guyette Does Not Inherently Disclose the Claimed Invention

Guyette does not inherently disclose, *inter alia*, a building material having a stress-relieving elastomer that acts as a stress relaxer between a cementitious substrate and a resin impregnated paper. In order for Guyette to inherently disclose the claimed elastomer, one of ordinary skill in the art must recognize that such an elastomer is “necessarily present” in Guyette. *Electro Medical Systems, S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 1052 (Fed. Cir. 1994). However, if the claimed elastomer is not a feature that is always present in Guyette, there is no inherency. *In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981); *see also Glaxo Inc. v. Novopharm Ltd.*, 52 F.3d 1043, 1047 (Fed. Cir. 1995) (because practice of the reference did not always yield the claimed polymorph, the reference did not anticipate the claim). Indeed, the “mere fact that a certain thing *may* result from a given set of circumstances is not sufficient.” *In re Oelrich*, 666 F.2d at 581 (“Inherency . . . may not be established by probabilities or possibilities.”).

Despite the clarity of the law, the Examiner claims that Guyette discloses an elastomer even though the Examiner appears to admit that the adhesive 20 of Guyette ***does not always*** have elastomeric properties. Indeed, the Examiner states that “[a]dhesives ***can be*** elastomers.” (Office Action at p. 4) (emphasis added). The fact that adhesive 20, at best and then only on certain undisclosed circumstances, ***can be*** an elastomer does not necessarily mean that it has the claimed properties.

Guyette provides for an epoxy, isocyanate/urethane, and polyvinyl acetate. The Examiner asserts that those adhesives can have elastomeric properties. Yet, there is no clear evidence that even those adhesives always have such properties. Indeed, the Examiner’s reference to Hawley’s Condensed Chemical Dictionary, Fourteenth Edition (the “Dictionary”) only suggests that one of ordinary skill in the art would not recognize those adhesives as necessarily having elastomeric properties. (*see e.g.*, Peng Declaration at ¶ 14.) For instance, the Dictionary states that: (1) epoxies “are characterized by toughness” and that most epoxy resins harden when blended; (2) polyurethanes have “excellent hardness”, “tend to harden and become brittle at low temperatures”, and can be rigid; and (3) polyvinyl acetate is a “strengthening agent for cements.” Those characteristics can hardly be called elastomeric. Thus, the Dictionary does not clearly show that the claimed elastomer is inherent in those adhesives and does not support the Examiner’s rejection of the claims. *See Continental Can Company U.S.A., Inc. v. Monsanto*

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Company, 948 F.2d 1264, 1268 (Fed. Cir. 1991) (“To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.”).

Moreover, the Examiner admits that not all epoxies have elastomeric properties and thus, the epoxies disclosed in Guyette would not always have elastomeric properties. (Office Action at p. 4 (“Guyette describes a broad range of epoxy and would thus include epoxies that have elastomeric properties.”)).

Accordingly, the adhesives of Guyette, including epoxies, do not always have a glass transition temperature between -90 and 50°C (*see e.g.*, Claim 8) or the elongation properties recited in Claims 22-26. Indeed, Applicant has found that the laminate structure of Guyette fails to withstand the test conditions recited in Claims 14-16. (*see* Specification at ¶¶ 6, 20, 33; *see also* Peng Declaration at ¶ 15).

Therefore, Guyette neither expressly nor even inherently discloses each and every limitation of Claims 1-3, 8-19, and 22-26. Accordingly, Guyette does not anticipate those claims, and thus, Applicant respectfully requests the Examiner to withdraw this rejection.

Allowable Subject Matter

The Examiner has objected to Claims 20 and 21 as being dependent upon a rejected base claim, but stated that those claims would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claim.

Claim 20 is dependent on independent Claim 17. Claim 21 is dependent on Claim 20. Applicant has amended Claim 20 to incorporate the limitations of independent Claim 17. Accordingly, Applicant submits that Claim 20, as amended, and Claim 21 are in condition for allowance.

Applicant respectfully requests that the Examiner allow Claims 20 and 21, and those claims which depend upon Claim 20.

New Claims

Applicant has added new Claims 27-28. Claims 27-28 depend on and incorporate the limitations of Claim 20, which as discussed above, has been amended and is in condition for

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allowance. Applicant submits that none of the cited references disclose, teach, or suggest the unique combination of features recited in the new claims. Accordingly, Applicant respectfully requests the Examiner allow Claims 27-28.

CONCLUSION

In view of the amendments and the foregoing remarks, Applicant submits that this application, as amended, is in condition for allowance and such action is respectfully requested. If any issues remain or require further clarification, the Examiner is respectfully requested to call Applicant's agent at the number indicated below in order to resolve such issues promptly. Also, if there are any additional fees, including any fees for extensions of time, or credit overpayment, please charge it to Deposit Account No. 07-0153.

Please address all further correspondence to Customer No. 60148. A new Power of Attorney and Correspondence Address Indication Form and Statement Under 37 CFR 3.73(b) by the Assignee of record is enclosed herewith.

Respectfully submitted,

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Date: 3/28/06

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